

REMARKS

Given that the finality of the last office action was withdrawn and prosecution reopened, Applicants respectfully submit that the Examiner should have entered the last amendment under rule 116 and should have considered the declarations under rule 131 that were submitted after the final office action, per MPEP 706.07(e). It appears from the action that the Examiner is using the prior version of the claims, rather than those submitted in the rule 116 amendment faxed in on May 13, 2004. Moreover, it appears that the Examiner has failed to consider the declarations under rule 131 that were submitted on June 13, 2004. Applicants respectfully submit that this is improper.

Applicants accordingly respectfully traverse the lists of claims that are set forth in paragraph 2 of the office action.

With respect to the paragraph 3 of the office action, this requirement is respectfully traversed. As explained in the rule 116 amendment mailed May 13, 2004, these claims should no longer be considered withdrawn, because the original dependency has been reasserted, making them inappropriate for a restriction requirement.

With respect to paragraph 7 of the office action, this objection is respectfully traversed. The Examiner's attention is directed to the cases of In re Moelands, 3 USPQ 2d 1474 (Bd. Pat. Appls. 1987) and In re Porter, 25 USPQ2d 1144 (Bd. Pat. Appls. 1992) both of which authorize this type of claim.

With respect to paragraph 8 of the office action, this objection is respectfully traversed. Any abbreviations appearing in the claims are believed to be defined in the specification, *please see e.g.* page 1, line 16 and page 12, line 7. Applicants accordingly respectfully submit that

adding a definition of abbreviations to the claims would be redundant and make the claims less readable.

#### Art rejections

The art rejections are respectfully traversed.

Since the references are complex, Applicants will confine their remarks to those portions cited by the Examiner, except as otherwise indicated. Applicants make no representation as to the contents of other portions of the references.

Any of the Examiner's rejections and/or points of argument that are not addressed below would appear to be moot in view of the following. Nevertheless, Applicants reserve the right to respond to those rejections and arguments and to advance additional arguments at a later date.

No arguments are waived and none of the Examiner's statements are conceded.

#### Lennon

Claim 1 -- per the amendment that should have been entered -- recites establishing a mapping from lists and scalars into XML. Claims 46 and 61 are analogous in this respect. By contrast, Lennon relates to linking metadata to objects in a video signal. This metadata appears to be of a descriptive nature, per the field of the invention section of the reference. Applicants are not able to find that there is any mapping between lists and XML in this reference.

Accordingly, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case against claim 1.

Claim 90 recites creating an annotated DTD from the constructs, and is dependent on claim 10, which relates to constructs of a mapping language. Claims 94 and 96 are similar in this respect. Column 11 of Lennon -- cited by the Examiner -- relates to adding annotations to an object. Lennon's column 6 explains that a "metadata object," as defined in the reference, is an XML document, *please see* lines 27-28. It appears therefore that the annotations in Lennon are added to the XML document, not to the DTD. Column 6 says the DTD is shown in Appendix A, while the XML document is shown in Appendix B. These are to be found in columns 14 and 15 of the reference. Looking at these appendices one can see that references to the annotations are appearing in the XML, not the DTD. Moreover, It appears that these annotations are mere descriptive material, having nothing to do with constructs of a mapping language -- unlike the claims -- *please see* col. 1, line 2 of the reference, which explains that the "metadata" is descriptive material. Applicants accordingly respectfully submit that the Examiner has failed to make a *prima facie* case against this group of claims.

It is also not clear whether this document is prior art in view of the rule 131 declarations. The Examiner apparently depends on the foreign priority data, but priority document is not of record, so it is not clear whether it contains the same material the Examiner cites or not.

#### Rittges

Applicants respectfully submit that the Examiner combines this unrelated reference with Lennon, due to impermissible hindsight in view of Applicants' disclosure. The Examiner has not indicated where the references teach or suggest any motivation to combine them, but rather

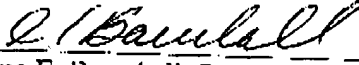
reasons from Applicants' specification and claims. Applicants respectfully submit that this is improper.

Moreover, this patent bears a foreign priority date of September 30, 1999. Therefore, in accordance with the rule 131 declarations previously submitted, this document does not appear to be prior art.

Please charge any fees other than the issue fee to deposit account 50-0510. Please credit any overpayments to the same account.

Applicants respectfully submit that they have addressed each issue raised by the Examiner - except for any that were skipped as moot - and that the application is accordingly in condition for allowance. Allowance is therefore respectfully requested.

Respectfully submitted by,

  
Anne E. Barschall, Reg. No. 31,089  
914-332-1019; fax 914-332-7719  
July 19, 2005